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## IN RE APPLICATION

OF: SCHELBERGER ET AL.

CONFIRMATION NO.: 1391

SERIAL No. 09/868,515

GROUP ART UNIT: 1617

FILED: JUNE 18, 2001

EXAMINER: SHAOJA A. JIANG

FOR: FUNGICIDAL MIXTURES BASED ON MORPHOLINE OR  
PIPERIDINE DERIVATIVES AND OXIME ETHER DERIVATIVES

I hereby certify that this correspondence is being deposited with the United States postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 on August 1, 2005.

(Ginger Pritchett)

Honorable Commissioner for Patents  
Alexandria, Virginia 22313-1450

REPLY UNDER 37 C.F.R. §1.111

Sir,

In reply to the office action of April, 1, 2005, it is respectfully requested the following remarks and amendments<sup>1</sup> be entered and considered for further prosecution of the above mentioned application:

REMARKS

Claims 12-23, 26-38 are pending in the current application. Claim 12 has been amended, and claims 23-24 have been canceled. The Examiner rejected claims 12-23, 26-38 under 35 USC §112, first paragraph, as containing subject matter that was not described in the specification at the time the application was filed, specifically the recitation of compound Id.. The Applicant points out that page 2, lines 1-5 of the

<sup>1</sup> The Claim Amendments as set forth in Appendix I of this paper.

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application as filed recites the structure of compound Ia, and moreover claim 1 as originally filed disclosed compound Ia. However, Applicant hereby amends claim 12 to include the limitations of claim 25 which now recite compounds Ia, Ib and Ic.

The Examiner also rejected claims 12-23 and 26-38 under 35 USC §112 for lack of enablement, in particular with respect to compound Ia. Claim 12 has been amended to recite compounds Ia, Ib and Ic. The Examiner has stated that Dr. Eberhard Ammermann's declaration<sup>2</sup> is fully persuasive as to compounds Ia, Ib, and Ic in combination with compound IIa. Applicant agrees that the declaration and Examples disclosed in the application show a synergistic effect in the combination of said compounds. Therefore favorable action is solicited.

The Examiner also rejected claims 12-38 under 35 USC §103(a) as being unpatentable over Schwalge et al. (WO 97/06681) and Kasahara et al. (WO 96/19442). The Examiner has argued that Schwalge et al. discloses a morpholine compound useful as a fungicidal compound and that Kasahara et al. discloses oxime derivatives useful as a fungicidal compound and that it would have been obvious to combine such compounds for controlling harmful fungi.

According to §103, in order to establish a prima facie case of obviousness, there must be (1) some suggestion or motivation to modify the references, (2) reasonable expectation of success and (3) the prior art reference must teach or suggest all of the claim limitations.<sup>3</sup>

The references cited herein do not teach or suggest all the claim limitations. Claim 1 recites, inter alia, the combination of compound I and compound II in a synergistically effective amount. The references, while mentioning fungicidal mixtures, do not teach or suggest the combination of compounds Ia, Ib, or Ic with compound of formula II in a synergistically effective amount or that such would have such synergistic effect.

Furthermore such synergistic effect is in itself evidence of non-obviousness.<sup>4</sup> The Examples along with Dr. Ammerman's declaration demonstrate an effect that is greater

<sup>2</sup> Declaration of Dr. Eberhard Ammermann filed November 2001

<sup>3</sup> See MPEP §2143

<sup>4</sup> Manual of Patent Examining Procedure §716.02(a)

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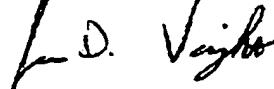
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than the sum of each component individually, or than would be expected in combination<sup>5</sup>. As can be seen from the Examples<sup>6</sup> and Dr. Ammerman's declaration,<sup>7</sup> the observed efficacy of the active compound compositions were much higher than the expected efficacy as derived by Colby's formula. For example, in the declaration the combination of Ia and IIa, at .25 and .06 ppm respectively, resulted in an observed degree of action of 100, whereas the expected degree of action as derived by the Colby formula was 84. Such unexpected results demonstrate the synergistic effects of the claimed combination. Therefore the Applicant respectfully requests that the §103 rejection be withdrawn.

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Respectfully submitted,  
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<sup>5</sup> See id.

<sup>6</sup> Application pg. 17, table 2

<sup>7</sup> Declaration pg. 4